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Application Serial No. 09/552,221  
Attorney Docket No. 944-003.007  
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TECHNOLOGY CENTER, 2800

### REMARKS

The Office Action mailed July 3, 2001, has been received by the Applicants and its contents carefully reviewed. The Applicants have considered the Examiner's reasoning in imposing a restriction requirement under 35 USC §121. Applicants respectfully disagree with the Examiner's reasoning and traverse the restriction requirement and believe the requirement is in error. Applicants have above made a provisional election of claims 8 through 17 in accordance with 37 CFR §1.143. Reconsideration and withdrawal of the restriction requirement is requested in view of the following remarks.

### **The Restriction Requirement Under 35 USC §121**

The Examiner has required applicants to elect between:

- I. claims 1-7, said to be drawn to a method for EMI shielding a portable electronic device, classified in class 29, subclass 830; and
- II. claims 8-17, said to be drawn to EMI shielding apparatus for a portable electronic device, classified in class 361, subclass 818.

Applicants traverse the restriction requirement because, as a practical matter, there is simply no way to search the claims of any of the groups—thoroughly—without searching for the other.

The scope and breadth of independent claims 1 and 8 both involve and revolve around insert molding an electrically conductive fiber mesh net into a wall of a portable electronic device to shield electronic circuitry contained within the device. Independent claims 1 and 8 are repeated below for convenience.

1. *Method for EMI shielding a portable electronic device characterized by insert molding an electrically conductive fiber mesh net into a wall of said device to shield first electronic circuitry contained within said device.*
8. *EMI shielding apparatus for a portable electronic device characterized by an electrically conductive fiber mesh net insert molded into wall surfaces defining an*

*interior cavity of said electronic device, said cavity having a size, shape and contour to surround first electronic circuitry within said electronic device.*

Applicants do not understand and cannot see how the method for EMI shielding a portable electronic device by insert molding an electrically conductive fiber mesh net into a wall of the electronic device “can be used any of chemical or etching instead of insert molding an electrically conductive fiber mesh net” as alleged by the examiner as a basis for claiming the inventions I and II are distinct to impose the restriction requirement. Both claims 1 and 8 require an electrically conductive fiber mesh net insert molded into the wall of the device.

The disclosure presents only a single invention. That invention may be described in several independent claims and from several perspectives, but that does not change the nature of the invention—the EMI shielding of a portable electronic device by insert molding an electrically conductive fiber mesh net into a wall of the device. Thus, all the claims have “a community of properties justifying their grouping which [is] not repugnant to principles of scientific classification” [*In re Harnish*, 631 F.2d 716, 206 U.S.P.Q. 300, 305, (C.C.P.A. 1980)].

More importantly, in general, an applicant has a “right to define what he regards as his invention as he chooses, so long as his definition is distinct” [*ibid.*]. And, “[a]s a general proposition, an applicant has a right to have each claim examined on the merits” [*In re Weber, Soden and Boksay*, 580 F.2d 455, 198 U.S.P.Q. 328, 331 (C.C.P.A. 1978)]. That court and its successor have long recognized the advantages to the public interest in permitting applicants to claim all aspects of the invention so as to encourage the making of a more detailed disclosure of all aspects of the discovery.

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112, all aspects of what they regard as their inventions, regardless of the number of statutory classes involved.

*In re Kuehl*, 177 U.S.P.Q. 250, 256 (C.C.P.A. 1973).

Since it is the case that the claims all relate to the same invention, even though the Patent Office classification system may indicate different places to list the patents after complete examination and allowance, searching the subject matter of one classification with that of others is

the only way to yield ALL references pertinent to the invention, and there is no undue burden for examination purposes.

The restriction requirement puts form over substance, utilizing an arcane procedure—unlike the unity of invention standard accepted more widely—that utilizes the classification system to segment an invention disclosure into differently classifiable parts and then declare that there are several inventions. It must be recalled that the classification system is made for the convenience of filing and retrieving documents. It is not a fair use of the classification system to say it is the standard to determine the number of inventions.

Moreover, requiring applicants to pay filing fees, prosecution costs, issue fees, and maintenance fees for several patents for one invention is an undue burden for Applicant.

Reconsideration and withdrawal of the requirement for restriction is believed in order and is requested.

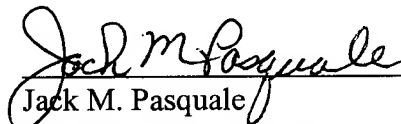
#### CONCLUSION

Applicants have made a significant advance in the art of EMI shielding portable electronic devices that has been shown above to involve one invention only. Accordingly, reconsideration and withdrawal of the restriction requirement and examination of all the claims is believed in order, and such actions are earnestly solicited.

Respectfully submitted

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